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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/801,883
Filing Date: March 08, 2001
Appellant(s): DEETMAN, GERBRAND

Mark F. Wachter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 23, 2008 appealing from the Office action mailed January 27, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,206,067	MACKINNON ET AL	6-1980
3,679,587	SMITH	7-1972
1,370,728	GREAT BRITIAN	10-1974

2,120,127

FRENCH

12-1971

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 131-152 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim Rejections - 35 USC § 103

1. Claims 131 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacKinnon et al (4,206,067) in view of Smith (3,679, 587).

MacKinnon discloses anti-erosion functional fluid comprising phosphate esters as the base fluid (col. 2, line 48-col. 3, and line 50); a perhalometalloidic salt (col. 3, line

52-col. 5, line 42) and an organic base (col. 5, line 45-col. 6, line 41). Furthermore, MacKinnon teaches that trialkyl phosphate esters are preferred esters for the base fluid (col. 2, line 64-67), MacKinnon teaches that dialkyl aryl phosphates, alkyl diaryl phosphates, etc. may also be employed as base fluid (col. 2, lines 48-63). Moreover, it is taught that the trialkyl phosphate esters that give optimum results are those having alkyl groups of 1 to 12 carbon atoms, preferably 4 to 9, and are either branched or straight chain configuration (col. 3, line 4-9). MacKinnon teaches the inclusion of epoxide hydrolysis inhibitors such as 3,4-epoxycyclohexylmethyl-3,4-epoxycyclohexanecarboxylate (col. 7, lines 17-20) and a specific diepoxide (col. 7, line 24-44); a methacrylic acid ester viscosity index improving agent having a molecular weight of from about 5,000 to 300,000 (col. 7, lines 63-col. 8, line 3); an oxidation inhibitor such as a hindered phenol di-t-butylparacresol (col. 7, lines 1-2); di(octylphenyl) amine (col. 8, line 18); and a foam inhibitor (col. 8, line 19).

MacKinnon teaches the inclusion of a perhalometalloidic salt, MacKinnon does not teach the inclusion of the presently required perfluoroalkylsulfonic acid.

Smith discloses a phosphate ester based functional fluid containing 0.001 to 5.0 parts of a perfluoroalkylsulfonic acid anti-erosion additive per 100 parts of the phosphate ester (col. 3, lines 4-52 and col. 1, lines 12-17). The addition of an epoxide acid scavenger such as 3,4-epoxycyclohexylmethyl 3,4-epoxycyclohexanecarboxylate is also taught (col. 8, lines 46-col. 9, line 8 and base fluid B, C, D and E).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, absent a showing to the contrary, to employ the perfluoroalkyl

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sulfonic acid as the perhalometalloidic acid which is an anti-erosion additive for phosphate ester based functional fluid and Smith teaches that the perfluoroalkyl sulfonic acid is an anti-erosion additive for a phosphate ester based functional fluid.

Claims 131-152 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackinnon (4,206,067) in view of Smith (3,679,587) and further in view of Great Britain (1,370,728) and French (2,120,127).

Mackinnon and Smith are relied upon as set forth above.

Mackinnon teaches the inclusion of various hindered phenols as oxidation inhibitors, Mackinnon does not disclose the inclusion of the presently preferred hindered polyphenols.

Great Britain '728 and French '217 teach the use of 4,4-methylene bis(2,6 di-*t*-butyl phenol), also known as Ethanox 702 as an antioxidant in a phosphate ester based functional fluid (claim 1 of page 9; and page 7, lines 10-46) and (Abstract and page 3, line 9), respectively.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, and absent a showing to the contrary, to employ the hindered polyphenol of either GB '728 or FR '127 as the hindered phenol oxidation inhibitor of Mackinnon because Mackinnon appears to invite the inclusion of any oxidation inhibitor which is preferably a hindered phenol (col. 6, line 66-col. 7, line 2) and the hindered phenols of both GB '728 and FR '127 are known to be employed as antioxidants in a phosphate ester based functional fluid.

(10) Response to Argument

1. Appellant argues and maintains that "claims 131-152 (the reissue claims) are not added in an attempt to recapture subject matter that was surrendered in the prosecution of the original application upon which the '551 Patent because the invention now claimed was never before claimed.

2. I. THREE STEP TEST FOR RECAPTURE:

In *Clement*, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three-step test for recapture analysis. In *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600, the court restated this test as follows: Application of the recapture rule is a three-step process. The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims.'.... The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter'.... Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

A. The First Step – Was There Broadening?

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance as to the nature of a "broadening claim." If the reissue claim is not broadened in any respect as compared to the patent claims, the analysis ends; there is no recapture.

Clearly, appellants' claims are directed to the additive package that is "suitable for use in any phosphate ester base stock fluid composition". The functional fluid of the amended reissue application does not require a specific phosphate ester based fluid, which is claimed more broadly, since it does not include the limitation to just the preferred phosphate esters "...in which the alkyl constituents are substantially isoalkyl C4 or C5". Any based fluid may be used according to the newly claimed reissue invention.

B. The Second Step - Does Any Broadening Aspect of the Reissued Claim Relate to Surrendered Subject Matter?

Where a claim in a reissue application is broadened in some respect as compared to the patent claims, the examiner must next determine whether the broadening aspect(s) of that reissue claim relate(s) to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination. This involves two sub-steps:

1. The Two Sub-Steps:

(A) It must first be determined whether there was any surrender of subject matter made in the prosecution of the original application, which became the patent to be reissued. If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to

subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by way of presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art. To determine whether such reliance occurred, the examiner must review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein. If there was no surrender of subject matter made in the prosecution of the original application, again the analysis ends and there is no recapture.

(B) If there was a surrender of subject matter in the original application prosecution, it must then be determined whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. All of the broadening aspects of reissue claims must be analyzed to determine if any of the omitted/broadened limitation(s) are directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.

Reviewing the prosecution history it can be clearly determined that appellants' broadened reissue claims relate to surrendered subject matter, according to the outlined test as stated above, that was amended to overcome the prior art to make the claims allowable. For example, appellant states, in his response filed June 28, 1994 in paper #6/C of application 08/099,267, "To similar effect is the express language of MacKinnon '674... "The alkyl group's maybe straight or branched chain, with straight-chain, such as n-butyl, preferred." In accordance with the foregoing express language of both

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MacKinnon '067 and MacKinnon '674, the trialkyl phosphate of choice is tri (n-butyl) phosphate. **This teaching, of course, is contrary to the requirements of the instant invention that the alkyl constituents attached to the phosphate moiety of the phosphate ester based stock component are substantially isoalkyl C4 or C5."**

C. The Third Step - Were the reissued claims materially narrowed in other respects to compensate for the broadening in the area of surrender, and thus avoid the recapture rule?

Reissue Claims are Narrower in Scope Than Patent Claims, in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope by Omitting Limitation(s) Added/Argued To Overcome Art Rejection in the Original Prosecution: In this case, there is recapture.

The reissue claims are narrower in scope to the patent claims, in an area not directed to amendment(s) made to overcome the art rejection in original prosecution and broader in scope by omitting limitations added to overcome art rejection in the original prosecution. For example, appellants have narrowed subject matter directed to the additive package (i.e., an epoxide compound; perfluoroalkyl sulfonic acid; methacrylate ester polymer; and a hindered phenol) and broadened the phosphate ester based stock component by omitting it entirely, which was added to overcome the art in the original patent. Therefore, as outlined in the Clement, 131 F.3d at 1470, and 45 USPQ2d at 1165 and explained in MPEP 1412.02 there is recapture that bars the reissue of claims 131-152.

3. In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
4. Appellant further argues that the secondary references add nothing to guide the skill artisan to the claimed invention.
5. The examiner contends that the prior art of record are all analogous art and are useful in lubricant compositions wherein the components are all well known ingredients useful for similar purposes. Therefore, the skilled artisan would have been motivated to combine the components or additives in the phosphate based composition of Mackinnon because only synergistic results would have been obtained in the absence of unexpected results commensurate in scope with the claimed invention.

An obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 2007 WL 1237837, at *12 (2007) ("The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

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6. Appellant argues that the Declaration submitted by Terry Wolfe in the Reissue application of 08/099,267 overcomes the Mackinnon in view of Smith rejection and Mackinnon in view of Smith and further in view of Great Britain '728 and French '127.

7. The examiner contends that the Declaration is not commensurate in scope with claims 131-152 which are not limited to tri-isobutyl phosphate or tri-butyl phosphates Examples 12 Table 11 and Example 13 Table 12. Instead appellant's broad claims are drawn to broad language such as phosphate esters and thus the claims are not commensurate in scope with the claimed invention. Accordingly, criticality cannot be established and the claims remain rejected as previously argued.

8. *Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980)*

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Necholus Ogden/

Primary Examiner, Art Unit 1796

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